

O/828/22

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING
IN RELATION TO TRADE MARK APPLICATION NO. UK00003756181
IN THE NAME OF DIAMOND ACES LIMITED
TO REGISTER AS A TRADE MARK**



IN CLASS 5

AND

**THE OPPOSITION THERETO
UNDER NUMBER 600002336
BY GOVIND THETHY**

BACKGROUND

1. On 29 March 2022, Diamond Aces Limited ('the Applicant') filed an application to register the mark shown on the front page of this decision, under number UK00003756181. The application was published for opposition purposes in the Trade Marks Journal on 15 April 2022. Registration is sought in respect of the following:

Class 5: Nutritional supplements; dietary and nutritional supplements; herbal supplements; mineral supplements.

2. On 25 April 2022, a Form TM7F (Notice of opposition and statement of grounds – [Fast Track]) was filed against the application by Mr Govind Thethy ('the Opponent'). On 18 May 2022, the Tribunal wrote to the Opponent, by email and by regular post, informing it that the Form TM7F, as filed, contained a number of defects, the most significant of which were as follows:

- It was unclear which of the goods covered by the earlier mark were being relied upon for the opposition because the Opponent had indicated that 'some' goods were being relied upon but, later on in the form, had stated 'class 5'. It was therefore unclear which particular class 5 goods were sought to be relied upon;

And

- The Opponent had indicated that it wished to rely upon section 5(1) of the Trade Marks Act 1994 ("the Act") for its ground of opposition, but that the parties' respective marks were clearly not identical.

3. The letter contained the following paragraphs:

"A period of 21 days from the date of this letter, that is, until **8 June 2022**, is allowed for your response. In the absence of any comments from you or an

amended notice of opposition, by the deadline requested, the Tribunal will consider striking out the opposition.

Please file an amended statement of grounds, on or before 8 June 2022.

If you choose not to amend the statement of grounds the registry may decide to strike out any grounds which are not adequately explained.'

4. On 15 June 2022, the Applicant wrote to the Tribunal requesting an update on the status of the proceedings.
5. On 20 June 2022, in the absence of any response from the Opponent, the Tribunal wrote to the Opponent, by email and by regular post, in the following terms:

"I refer to the above proceedings and the official letter dated 18 May 2022, copy attached for ease of reference. I also refer to the applicant's letter dated 15 June 2022.

It is noted the opponent has not filed an amended TM7F and statement of case addressing the issues raised on the official letter attached.

A further period of 14 days is given for the opponent to file an amended TM7F and statement of grounds; i.e. on or before **4 July 2022**.

If you choose not to file an amended TM7F the registry may decide to strike out any grounds which are not adequately explained."

6. On 8 August 2022, the Applicant wrote to the Tribunal requesting an update on the status of the proceedings.
7. On 9 August 2022, in the absence of any response from the Opponent, the Tribunal wrote to the Opponent, by email and by regular post, in the following terms:

“I refer to the above proceedings, the applicant’s email dated 8 August 2022 and the official letters dated 18 May 2022, 20 June 2022 and 8 July 2022. The Registry has noted that the opponent has not filed an amended statement of case which clarifies the grounds of the opposition. In the absence of this information it is the Registry’s preliminary view that the opposition be struck out.

In accordance with paragraph 10 of Tribunal Practice Notice 2/2011, if either party disagrees with the preliminary view they should provide full written reasons within 14 days from the date of this letter, which is on or before **23 August 2022**.

If no response is received within the time allowed, the preliminary view will automatically be confirmed and the trade mark application will proceed to registration.”

8. On 11 August 2022, the Opponent wrote to the Tribunal by email asking for direction on how to complete his Form TM7F.
9. On 12 August 2022, the Tribunal wrote to the Opponent, by email and by regular post, in the following terms:

“I refer to your email dated 11 August 2022.

On the 18 May 2022 the Registry issued an official letter requesting that you file an amended TM7F on or before 8 June 2022. It stated that;

A period of 21 days from the date of this letter, that is, until 8 June 2022, is allowed for your response. In the absence of any comments from you or an amended notice of opposition, by the deadline requested, the Tribunal will consider striking out the opposition.

Guidance was provided as follows;

Further information on the opposition process and a scale of costs are available at <https://www.gov.uk/government/publications/trade-marksstandardopposition/guidance-standard-opposition-proceedings-before-the-trademarktribunal>.

It was issued to the email address that you provided on the TM7F. No response was received.

On the 20 June 2022 the Registry re-issued an official letter requesting that you file an amended TM7F on or before 4 July 2022. The correspondence was issued by email and post, no response was received.

On the 8 July 2022 the Registry re-issued an official letter requesting that you file an amended TM7F on or before 22 July 2022. The correspondence was issued by email and post, no response was received. I have attached all of the correspondence for your reference.

On the 9 August 2022 the Registry issued an official letter and preliminary view that;

The Registry has noted that the opponent has not filed an amended statement of case which clarifies the grounds of the opposition.

In the absence of this information it is the Registry's preliminary view that the opposition be struck out.

In accordance with paragraph 10 of Tribunal Practice Notice 2/2011, if either party disagrees with the preliminary view they should provide full written reasons on or before **23 August 2022**.

If no response is received within the time allowed, the preliminary view will automatically be confirmed and the trade mark application will proceed to registration.

The Registry maintains the preliminary view that;

In the absence of the amended TM7F it is the Registry's preliminary view that the opposition be struck out.

In accordance with paragraph 10 of Tribunal Practice Notice 2/2011, if either party disagrees with the preliminary view they should provide full written reasons and request a hearing on or before **23 August 2022**.

You are also required to provide the Hearing Officer with detailed reasons for your failure to respond to Registry requests to amend your TM7F.

If no response is received within the time allowed, the preliminary view will automatically be confirmed and the trade mark application will proceed to registration."

10. On 23 August 2022, the Opponent filed another version of its Form TM7F which, despite containing several minor deficiencies, was, on the whole, admissible. Section 5(2)(b) of the Act was confirmed as the ground of opposition.
11. On 8 September 2022, the Tribunal wrote to the Opponent, by email and by regular post, in the following terms:

"The Registry acknowledges receipt of the amended TM7F received on 23 August 2022. The Registry has reviewed the case and in the light of:

the passage of time since the TM7F was initially filed;

the numerous opportunities given to the Opponent to rectify the defects and the failure of the Opponent to provide reasons for the lateness of the amended TM7F

the failure to request a Case Management Conference on or before 23 August 2022, **the Registry maintains the preliminary view that the opposition should be struck out.**

In accordance with paragraph 10 of Tribunal Practice Notice 2/2011, if either party disagrees with the preliminary view they should request a hearing within 7 days from the date of this letter; that is on or before **15 September 2022**. To accommodate that possibility a provisional case management conference (CMC) date has been scheduled for **1.30pm on Friday 16th September 2022**.

If the parties do not request a hearing the provisional CMC will be vacated and the provisional view will automatically be confirmed.

Consequently, the opposition will be withdrawn and the application will proceed to registration.”

THE JOINT HEARING

12. The hearing took place before me, by telephone conference, on 16 September 2022. The Applicant confirmed that it would not be attending. The Opponent, Mr Thethy, represented himself.

13. The Opponent’s explanation for its failure to respond to the Registry’s repeated requests, and subsequent late filing of an amended Form TM7F, can, in so far as is relevant, be summarised as follows:

- Mr Thethy stated that he knew the Applicant and that he had decided to contact them directly to avoid ‘a lengthy process’.
- Mr Thethy stated that the Tribunal’s second letter (dated 8 June 2022) was sent directly to his accountant, who was on holiday at the time. He said that the address to which the Tribunal has sent its letters was not his correspondence address.

- Mr Thethy explained that he was a small business comprising only himself and that he has neither the expertise to deal with the opposition matter nor the means to appoint a legal representative. He emphasised that he does not have professionals to advise him and that he was therefore asking for the Tribunal to give him ‘some leeway’ because he does not know how to navigate the opposition process.

14. I asked Mr Thethy to explain why he had not replied to the Tribunal’s letter of 18 June 2022. He replied that that letter had been sent to his accountant, who was on holiday at the time.

15. I asked Mr Thethy if he could remember what dates he did eventually have sight of the letters dated 18 May and 20 June 2022. He was unable to say.

16. I asked whether there was anything further that Mr Thethy wished to tell the Tribunal. Mr Thethy said that, for small companies like his own, opposition proceedings were ‘a very big thing’. He pointed out that he had completed the Form TM7F in time for the most recently imposed deadline of 23 August 2022.

17. I indicated that I would not be giving an *ex tempore* decision but that I would reserve judgment and write out to the parties within five business days.

DECISION

18. As outlined at 1.8 of the Manual of trade marks practice (“the Manual”), the Tribunal adheres to the same overriding objective as the court for dealing with cases justly. This is set out in rule 1.1 of the Civil Procedure Rules 1998 (as amended) and includes, so far as is practicable:

(2) (a) Ensuring that the parties are on an equal footing

(b) Saving expense

(c) Dealing with the case in ways which are proportionate –

(i) to the amount of money involved (ii) to the importance of the case (iii) to the complexity of the issues and (iv) to the financial position of each party
(d) Ensuring that it is dealt with expeditiously and fairly and

(e) Allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases.

19. Rule 62 of the Rules, so far as is relevant, provides:

“62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may —

(a) require a document, information or evidence to be filed within such period as the registrar may specify;

...

(3) When the registrar gives directions under any provision of these Rules, the registrar may—

(a) make them subject to conditions; and

(b) specify the consequences of failure to comply with the directions or a condition.”

20. Tribunal Practice Notice ('TPN') 1/2018 states:

“Failure to Follow Directions

11. Failure to comply with directions under Rule 62 may have the following consequences:

...

(iv) where there is a serious risk of unfairness to, or oppression of, the other party, directions will be made subject to the condition (per Rule

62(3) that failure to comply with them will result in the opposition/application being struck out in whole or in part.”

Conclusions

21. The reasons that Mr Thethy has provided to explain: his failure to reply to the Tribunal’s requests; and late-filed form TM7F, are not compelling. With regard to Mr Thethy’s explanation that he had decided to contact the Applicant directly, this course of action would not have relieved the Opponent of his obligation to reply to the Tribunal’s requests in order to institute the opposition proceedings.
22. The letters sent by the Tribunal to the Opponent were sent to both the postal and email addresses provided by the Opponent in the various iterations of his Form TM7F. The Tribunal therefore had no reason to question the correctness of these contact details.
23. I now consider Mr Thethy’s invitation for the Tribunal to make a concession in view of the fact that the Opponent runs a small business which, according to Mr Thethy, lacks the knowledge or means to appoint a legal representative to deal with the opposition proceedings. Whilst it is appreciated that legal proceedings can be somewhat daunting to the lay person, Mr Thethy took the decision to file an opposition claim and, in my view, should have reasonably expected that a certain amount of subsequent correspondence and engagement with the Tribunal would be necessary. It is my firm view that the pieces of correspondence sent to the Opponent have been drafted in the clearest possible terms and that the nature of the Tribunal’s requests does not necessarily warrant legal expertise. The filing of a Form TM7F is a relatively straightforward task, and the Tribunal receives many oppositions from litigants-in-person who file correctly completed forms in a timely manner without professional representation. The Opponent is, like any prospective Opponent, lay person or otherwise, free to seek legal advice if it so chooses.
24. I am mindful that the Tribunal is intended to be a low-cost and accessible means of access to justice and that it has a duty to ensure that proceedings are dealt with efficiently and fairly. In my view, the Opponent has been given ample opportunity

and guidance on the correct manner of filing a Form TM7F by the given deadlines. The reasons provided by the Opponent for the failure to respond to the Tribunal's requests, and the late-filed Form TM7F, are, in my view, unsatisfactory. While the Opponent has not elected to be legally represented, I am mindful of the guidance given in TPN 1/2018, and I consider that the Opponent has been given equal access to justice.

25. I have also borne in mind the following from Mr Justice Hobbs K. C. as the Appointed Person in O/399/15 BOSCO:

“18. It continues to be the position in civil proceedings in the High Court that: ‘... if proceedings are not to become a free-for-all, the court must insist on litigants of all kinds following the rules. In my view, therefore, being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules’: R (Hysaj) v Secretary of State for the Home Department [2014] EWCA Civ. 1633 at paragraph [46] per Moore-Bick LJ, Vice-President of the Court of Appeal, with whom Tomlinson LJ and King LJ agreed. In the same vein, it was observed in Nata Lee Ltd v Abid [2014] EWCA Civ. 1652 at paragraph [53] per Briggs LJ with whom Moore-Bick LJ, Vice-President of the Court of Appeal, and Underhill LJ agreed, that: ‘... the fact that a party (whether an individual or a corporate body) is not professionally represented is not of itself a reason for the disapplication of rules, orders and directions, or for the disapplication of the overriding objective which now places great value on the requirement that they be obeyed by litigants. In short, the CPR do not, at least at present, make specific or separate provision for litigants in person. There may be cases in which the fact that a party is a litigant in person has some consequence in the determination of applications for relief from sanctions, but this is likely to operate at the margins’.

19. The same approach should, in my view, be adopted in relation to the need for compliance with rules, orders and directions in Registry proceedings under the 1994 Act and the 2008 Rules.

...”

26. The Registrar has a duty to ensure that the system is fair to both parties. I am conscious that during the time between the first inadmissible Form TM7F being filed in April 2022 and the preliminary view given in August 2022 that the opposition be struck out in its entirety, the Applicant has suffered a great deal of inconvenience, as well as uncertainty on the outcome of its application.

27. Given the passage of time since the proceedings were first initiated, keeping in mind the necessity of equality between the parties, the public interest in resolving disputes efficiently, and allowing that the Tribunal has a duty to allocate its resources fairly, I consider that the preliminary view to strike out the opposition should be upheld. The opposition is therefore struck out in its entirety.

OUTCOME

28. Subject to any successful appeal against this decision, the application will proceed to registration.

COSTS

29. Given that this decision terminates the proceedings, it is appropriate for me to address the matter of costs. No Form TM8 has been filed in these proceedings and the Applicant did not attend the hearing. Whilst it is reasonable to assume that the Applicant has taken time to review the various iterations of Form TM7F and the multiple correspondences in these proceedings to date, no claim for costs has been made. I therefore direct that there is no order for costs.

Dated this 26th day of September 2022

N. R. MORRIS

For the Registrar